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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/862,917	05/22/2001	Michael Jarman	708P009508-US(PAR)	8732
7590 10/04/2007 Craig A. Fieschko DEWITT ROSS & STEVENS S.C. 8000 Excelsior Drive, Suite 401 Madison, WI 53717-1914			EXAMINER BORISSOV, IGOR N	
			ART UNIT 3628	PAPER NUMBER
			MAIL DATE 10/04/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/862,917

Applicant(s)

JARMAN ET AL.

Examiner

Igor N. Borissov

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21,23-26 and 28-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21,23-26 and 28-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/18/2007 has been entered.

### ***Response to Amendment***

Amendment received on 07/18/2007 is acknowledged and entered. Claims 1, 18, 19, 21, 28, 35, and 36 have been amended. Claims 22 and 27 have been canceled. Claims 1-21, 23-26, 28, and 35-41 are currently pending in the application.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1-12, 14-21, 23, 28 and 35-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al. (US 6,529,883) in view of Peddie et al. (US 4,351,028).**

#### **Independent claims**

Claim 1. Yee et al. (Yee) teaches a utility transaction authorization system, comprising:

a user interface unit (a customer terminal) capable of accepting a transaction authorization (Fig. 1, item 11; C. 4, L. 49-50);

a utility meter provided at a location having an associated location identifier (meter location ID) unique to the location, wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization together with meter location ID, and to conduct a transaction based on the transaction authorization and meter location ID, thereby indicating obtaining authorization of the transaction (C. 4, L. 58 - C. 5, L. 2; C. 6, L. 3-12).

While Yee does teach communicating information (including meter identification number and a utility account number) between the meter and the utility (C. 3, L. 29-67), and while Yee teaches obtaining authorization of the transaction, Yee does not specifically teach that the utility meter transmits said authorization request to obtain said authorization of the transaction.

Peddie et al. (Peddie) teaches a utility transaction authorization system, including a utility meter, a modem, and utility payment unit 24 which enables consumers to pay the utility by a direct debit on their bank account or by making use of a credit card facility, this being done over a data link 26 leading to a central processor at the utility, thereby indicating transmitting an authorization request to credit card facility (Fig. 1; C.3, L. 53-57). Furthermore, paying by the credit card from consumer's premises via a credit card reader installed at the user premises indicates providing authorization request including: data identifying a credit card account, and data verifying that said credit card is physically present at the location of the consumer's interface unit.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yee to include that that the utility meter transmits said authorization request to obtain said authorization of the transaction, as disclosed in Peddie, because it would advantageously allow to delegate this task to a third party service provider, thereby allowing to use less powerful processor in the meter and decrease operating cost. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 28. Yee teaches a utility transaction authorization method, comprising:  
providing a user interface unit (a customer terminal) at a location (Fig. 1, item 11; C. 4, L. 49-50);  
providing a utility meter at the location, the utility meter having an associated location identifier uniquely identifying the location (Fig. 1, item 12; C. 6, L. 11);  
accepting a transaction authorization request via the user interface unit (C. 4, L. 49-50);  
communicating the transaction request from the user interface unit to the utility meter (C. 4, L. 58-62);  
wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization together with meter location ID, and to conduct a transaction based on the transaction authorization and meter location ID, thereby indicating obtaining authorization of the transaction (C. 4, L. 58 - C. 5, L. 2; C. 6, L. 3-12).

While Yee does teach communicating information (including meter identification number and a utility account number) between the meter and the utility (C. 3, L. 29-67), and while Yee teaches obtaining authorization of the transaction, Yee does not specifically teach that the utility meter transmits a message including said authorization request to obtain said authorization of the transaction.

Peddie teaches a utility transaction authorization system, including a utility meter, a modem, and utility payment unit 24 which enables consumers to pay the utility by a direct debit on their bank account or by making use of a credit card facility, this being done over a data link 26 leading to a central processor at the utility, thereby indicating transmitting an authorization request to credit card facility (Fig. 1; C.3, L. 53-57). Furthermore, paying by the credit card from consumer's premises via a credit card reader installed at the user premises indicates providing authorization request including: data verifying that said credit card is present at the location of the consumer's interface unit, and data identifying a credit card account of the credit card.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yee to include that the utility meter transmits said authorization request to obtain said authorization of the transaction, as disclosed in Peddie, because it would advantageously allow to delegate this task to a third party service provider, thereby allowing to use less powerful processor in the meter and decrease operating cost. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 35. Yee teaches a utility transaction authorization method, comprising:  
a user interface unit capable of accepting transaction data, the transaction data including credit/charge card data identifying a credit/charge card to be charged for the transaction (Fig. 1, item 11; C. 4, L. 49-50);

a utility meter provided at the location of the cardholder and being separate from the user interface unit (Fig. 1, items 12 and 11), and having an associated location identifier uniquely identifying the location (Fig. 1, item 12; C. 6, L. 11);

wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization together with meter location ID, and to conduct a transaction based on the transaction authorization and meter location ID, thereby indicating obtaining authorization of the transaction (C. 4, L. 58 - C. 5, L. 2; C. 6, L. 3-12).

While Yee does teach communicating information (including meter identification number and a utility account number) between the meter and the utility (C. 3, L. 29-67), and while Yee teaches obtaining authorization of the transaction, Yee does not specifically teach that the utility meter transmits said authorization request including said authorization request to obtain said authorization of the transaction.

Peddie teaches a utility transaction authorization system, including a utility meter, a modem, and utility payment unit 24 which enables consumers to pay the utility by a direct debit on their bank account or by making use of a credit card facility, this being

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done over a data link 26 leading to a central processor at the utility, thereby indicating transmitting an authorization request to credit card facility (Fig. 1; C.3, L.. 53-57). Furthermore, paying by the credit card from consumer's premises via a credit card reader installed at the user premises indicates providing authorization request including: data verifying that said credit card is present at the location of the consumer's interface unit, and data identifying a credit card account of the credit card.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yee to include that the utility meter transmits said authorization request to obtain said authorization of the transaction, as disclosed in Peddie, because it would advantageously allow to delegate this task to a third party service provider, thereby allowing to use less powerful processor in the meter and decrease operating cost. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

Claim 37. Yee teaches a utility transaction authorization method, comprising:  
a user interface unit capable of accepting transaction data, the transaction data including credit/charge card data identifying a credit/charge card to be charged for the transaction (Fig. 1, item 11; C. 4, L. 49-50);

a utility meter provided at the location of the cardholder and having an associated location identifier uniquely identifying the location (Fig. 1, item 12; C. 6, L. 11);

wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization together with meter location ID, and to conduct a transaction based on the transaction authorization and meter location ID, thereby indicating obtaining authorization of the transaction (C. 4, L. 58 - C. 5, L. 2; C. 6, L. 3-12).

While Yee does teach communicating information (including meter identification number and a utility account number) between the meter and the utility (C. 3, L. 29-67), and while Yee teaches obtaining authorization of the transaction, Yee does not

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specifically teach that the utility meter transmits said authorization request including said authorization request to obtain said authorization of the transaction.

Peddie teaches a utility transaction authorization system, including a utility meter, a modem, and utility payment unit 24 which enables consumers to pay the utility by a direct debit on their bank account or by making use of a credit card facility, this being done over a data link 26 leading to a central processor at the utility, thereby indicating transmitting an authorization request to credit card facility (Fig. 1; C.3, L. 53-57). Furthermore, paying by the credit card from consumer's premises via a credit card reader installed at the user premises indicates providing authorization request including: data verifying that said credit card is present at the location of the consumer's interface unit, and data identifying a credit card account of the credit card.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yee to include that that the utility meter transmits said authorization request to obtain said authorization of the transaction, as disclosed in Peddie, because it would advantageously allow to delegate this task to a third party service provider, thereby allowing to use less powerful processor in the meter and decrease operating cost. Furthermore, so as this is a case where the improvements are no more than the predictable use of prior art elements according to their established functions, no further analysis for "motivation to combine" is required by the Examiner. *KSR*, 127 S.Ct. at 1740, 82 USPQ2d at 1396.

#### Dependent claims

Claims 2-5, 8-12. Peddie teaches a communication unit arranged to communicate with an authorization authority (Fig. 1; C.3, L. 53-57).

Claim 6. Yee teaches said system in which said further meter is a gas or water meter (C. 4, L. 14).

Claim 7. Yee teaches said system in which the utility meter is an electricity meter (Fig. 1 ).

Claims 14-16. Yee teaches said system in which the user interface unit and the utility meter communicate with each other via RF signals (C. 4, L. 16).



Claims 17, 21-23, 27 and 36. See reasoning applied to claim 1.

Claim 18. Yee teaches said system in which the user interface unit includes a keyboard (Fig. 1).

Claim 19. Yee teaches said system in which the utility meter includes a memory for storing a user's banking data (Fig. 5, item 64).

Claim 20. Yee teaches said system in which in which the user interface unit includes a display (Fig. 1).

Claims 38-41. Said method and system, wherein the funds transfer authorization, authorization request and corresponding funds transfer are independent of any utility usage data generated by the utility meter (because the credit/charge card payment is based on the availability of funds or amount of credit, and is not based on the type of goods or services the funds are spent for).

**Claims 13 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yee et al. in view of Peddie et al. and further in view of Bos (WO 00/58922).**

*Dependent claims*

Claim 13. Yee in view of Peddie teach all the limitations of claim 13, except specifically teaching that the user interface unit is a telephone.

Bos teaches a utility transaction authorization system, including a meter and a digital cellular phone which is used by a consumer to obtain payment authorization (Fig. 1; Abstract).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Yee in view of Peddie to include that the user interface unit is a telephone, as disclosed in Bos, because it would advantageously allow to combine various functionalities in one mobile device, thereby providing convenience to the user.

Claims 24-26. See reasoning applied to claim 13.

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### ***Response to Arguments***

Applicant's arguments filed 07/18/2007 have been fully considered but they are not persuasive.

Applicant argues that modifying Yee to include communication of a transaction authorization from the meter to the utility would make Yee unsatisfactory for its intended purpose.

In response to applicant's argument, the examiner points out that Yee system specifically teaches communicating information (including meter identification number and a utility account number) between the meter and the utility (C. 3, l. 29-67), and obtaining authorization of the transaction. A necessary infrastructure, including network connection between a bank, utility, and meter, is in place. Furthermore, the step of communicating financial information is disclosed. Therefore, modification of Yee to add that said financial information includes transaction authorization cannot change or destroy Yee system. As per applicant's argument that there is no *direct* communication between the meter and the utility company, it is noted that Yee teaches, that meter information obtained by the service technician, is stored on a disk, and then is communicated to the utility by direct coupling to utility information systems, or via the Internet, or via a power line carrier link (C. 3, L. 8, 36-40). Connecting the meter to the power line carrier link suggest said *direct* feature.

In response to the applicant's argument that transmitting authorization request in Peddie does not include location information, it is noted that Yee teaches said utility meter, which is provided at a location having an associated location identifier (meter location ID) unique to the location, wherein the utility meter is arranged to communicate with the user interface unit, to obtain a transaction authorization together with meter location ID, and to conduct a transaction based on the transaction authorization and meter location ID (C. 4, L. 58 - C. 5, L. 2; C. 6, L. 3-12).

At this point the examiner stipulates that Applicant argues against the references individually; but one cannot show nonobviousness by attacking references individually

where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

The remaining applicant's arguments essentially repeat the arguments presented above; therefore, the responses presented by the examiner above are equally applicable to the remaining applicant's arguments.

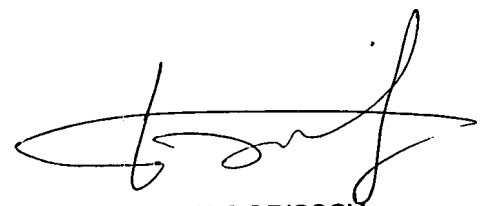
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Igor Borissov whose telephone number is 571-272-6801. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

IB

9/18/2007



IGOR N. BORISSOV  
PRIMARY EXAMINER